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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,878

09/15/2006

Siegfried Ansorge

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EXAMINER

COPPINS, JANET L

ART UNIT

PAPER NUMBER

1626

NOTIFICATION DATE

DELIVERY MODE

10/07/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary	Application No. 10/575,878	Applicant(s) ANSORGE ET AL.	
	Examiner JANET L. COPPINS	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 118-137 is/are pending in the application.
- 4a) Of the above claim(s) 129-137 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 118-126 is/are rejected.
- 7) ☒ Claim(s) 127 and 128 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 118-137 are currently pending in the instant application.

Priority

1. The instant application is a national stage entry of PCT/EP04/11644, filed October 15, 2004, which claims priority to German application no. 103 48 044.7, filed October 15, 2003. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Should applicant desire to perfect the benefit of foreign priority under 35 U.S.C. 119(a)-(d), a certified English translation of the foreign application must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e).

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on November 30, 2006, May 5, 2009, and April 7, 2010 were in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. The IDS documents were considered.

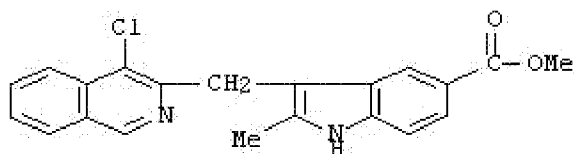
Election/Restrictions

3. Applicant's election without traverse of Group I in the reply filed on July 8, 2010 is acknowledged.

4. This application is being examined as per MPEP 803.02, the Examiner will determine whether the entire scope of the claims is patentable. Applicants' elected species of compound C4.002 makes a contribution over the prior art of record. Therefore, according to MPEP 803.02: should the elected species appear allowable, the search of the Markush-type claim will be extended. If the search is extended and a non-elected species is not found allowable, the Markush-type claim shall be rejected and claims to the nonelected invention held withdrawn

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from further consideration. The search of the Markush-type claim has been extended to include the products of formula and variants thereof:



As a non-elected species has been found not allowable, the Markush-type claims have been rejected and claims to the nonelected invention held withdrawn from further consideration. Subject matter not embraced by the elected embodiment or the above identified nonelected species is therefore withdrawn from further consideration. It has been determined that the entire scope claimed is not patentable.

Status of the Claims

5. Currently, Claims 118-137 are pending in the instant application. Claims 129-137 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention and species. Claims 118-128, read on an elected invention and species and are therefore under consideration in the instant application.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 118-126 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 118 recites the limitation "X1, X2, X3, and X4 represent identical or different carbon units." This limitation is unclear because the term "carbon units" is not defined in the specification. If this term means a) carbon atoms, then one cannot determine how one carbon atom can be different from another. If this term means b) carbon atoms and their derivatives, implying varying substituents on any of these carbon atoms, then these derivatives are indefinite because they are not defined in the specification. A definition of a chemical compound cannot be open-ended, but must be claimed with precision. The identity of the additional atoms or groups and how to determine the identity of the additional atoms or groups is not pointed out or distinctly claimed. It is unclear what the other atoms can be on the ring carbon, and what else is present on the structure of formula C4.

Claim 118 recites the limitation, "R1 and R2 symbolize a substitution pattern of a respective partial ring," The terms "substitution pattern" and "respective partial ring" are not defined in the specification and while the identity of R1 and R2 are defined, the identity of the additional atoms or groups and how to determine the identity of the additional atoms or groups is not pointed out or distinctly claimed. A definition of a chemical compound cannot be open-ended, but must be claimed with precision and Examiner cannot ascertain the metes and bounds of compounds of formula C4.

Claims 124-126 recite the limitation, "wherein the substituents R1 represent hydrogen." Since R1 represents from one to four substituents, it is unclear if these limitations mean that a) all substituents R1 are identical and all hydrogen or that b) one of substituents R1 can be hydrogen at any given time.

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 118-126 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pamukcu et al. (U.S. Patent no. 6,410,584).

Pamukcu et al. teaches the following compounds and pharmaceutical compositions for the treatment of various diseases that anticipate the instantly claimed compounds of formula C4.

Figure 4, compounds 46, 47, 48

Figure 5, compounds 52, 53, 54

Figure 6, compounds 58, 59

Figure 7, compounds 60, 62

Figure 8, compounds 66, 67, 68, 69

Figure 9, compounds 70, 71, 72, 73, 74

Figure 10, compounds 75, 76, 77

Figure 11, compounds 81, 82, 83, 84

Note: These are just examples of some anticipatory compounds. There are many more located in Figures 12-29.

In all of the aforementioned compounds, X1, X2, X3, and X4 are carbon atoms. Y1 is NH, Y2 and Y3 are carbon atoms. R1 is a substituted carbonyl (and hydrogen in some instances). One R2 is methyl and the other is substituted methyl.

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Claim Objections

10. Claims 127-128 are objected to for depending on a rejected base claim and containing further nonelected subject matter.

Conclusion

11. No claims are allowed.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Janet L. Coppins** whose telephone number is **571-272-0680**.

The examiner can normally be reached on Monday thru Thursday 9-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Janet L. Coppins
Patent Examiner, Art Unit 1626
September 30, 2010

Joseph K. McKane
Supervisory Patent Examiner,
Art Unit 1626

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/Susannah Chung/

Primary Examiner, Art Unit 1626